

## REMARKS

Reconsideration and allowance in view of the following remarks are requested. No amendments have been made. Applicant respectfully requests reconsideration of the objections and rejections, which are discussed below.

### **Double Patenting Rejection**

Claims 1-10 and 12-15 were rejected on the ground of non-statutory obviousness-type double-patenting as being unpatentable over: 1) claims 8-27 of U.S. Patent No. 7,357,077 to Adamczyk in view of U.S. Patent 6,060,143 to Tompkin et al.; 2) claims 1-24 of U.S. Patent No. 7,686,341 to Adamczyk in view of U.S. Patent 6,060,143 to Tompkin et al.; and 3) U.S. Patent No. 7,311,043 to Mayer et al. in view of U.S. Patent 6,060,143 to Tompkin et al. Applicants respectfully request that this rejection be held in abeyance until claims of the present application have been found to be in condition for allowance. If at that time the rejection still stands, Applicants will file a terminal disclaimer if appropriate.

### **Claim Rejections**

Claims 1-6, 8-10 and 13-16 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,098,546 to Schell (“Schell”) in view of U.S. Patent 6,060,143 to Tompkin et al. (“Tompkin”). Applicants traverse the rejection on the basis that the combination of Schell in view of Tompkin fails to disclose or suggest all of the limitations required by claims 1-6, 8-10 and 13-16.

Independent claims 1 and 16 require a data carrier which is partly covered with a protective foil such that the tactile perceptibility of the intaglio imprint is maintained. Similarly, independent claim 14 requires that the protective foil has a corresponding window area. The Office Action concedes that Schell fails to disclose these limitations and alleges that Tompkin

discloses a carrier foil 3 having optically effective structures 6 which are covered by a cover layer 9, where the optically effective structure 6 and the cover layer 9 are interrupted by openings 16, 17 (see, Fig. 2 of Tompkin). The Office Action characterizes cover layer 9 which is disclosed in the context of Fig. 9 to be a dielectric or metallic layer (see, column 7, lines 46 and 47 of Tompkin), as the “protective foil” required by independent claims 1, 14 and 16. The cover layer 9 of Tompkin, however, is not a protective foil. To the contrary, Tompkin teaches that the cover layer 9 is tens of nanometers thick (column 8, lines 54 to 56), which is sufficient for the purposes of visibly covering and revealing portions of the underlying surface, but is not sufficient to perform the protective function required by the protective foil of the present claims. The protective foil of claims 1, 14 and 16 has a thickness of approximately 6 to 150  $\mu\text{m}$ , which is three orders of magnitude thicker than cover layer 9 of Tompkin. See paragraph [0029] of the present application. If cover layer 9 were applied to the surface of the web 9 of Schell, this would not result in a “protective foil” as required by the independent claims, since the thickness of cover layer 9 is several order of magnitudes smaller than the relief height of the intaglio imprint of Schell and thus no protective function for the intaglio imprint would be achieved. For these reasons, Tompkin fails to disclose the protective foil of claims 1, 14 and 16 and therefore the combination of Schell and Tompkins fails to disclose or suggest all of the limitations of the independent claims.

Additionally, the structures 6 of Tompkin, which might be produced by embossing, are described as optically effective structures (see, Tompkin, Col. 2, lines 17-30) and thus show a relief height in the order of magnitude of the wavelength of visible light, i.e. 0.5  $\mu\text{m}$ . Such a relief height would have no tactile perceptibility (see, e. g., paragraph [0024] of the present application). Openings 16 and 17 of Tompkin would not have any effect on tactile perceptibility

but rather provide light conductor properties to the carrier foil 3 of Tompkin, as shown in Fig. 2 and the corresponding description (Tompkin, Col. 3, Line 55 – Col. 4, Line 14). Consequently, a skilled person would have no reason to apply the cover layer 9 of Tompkin to the surface of the web 9 of Schell directly, without providing an additional transparent carrier foil 3 as disclosed in Tompkin, since otherwise the intended light conductor properties would not be achieved. For this additional, independent reason, Tompkin fails to suggest the protective foil of claims 1, 14 and 16 and the combination of Schell and Tompkin would not yield the claimed invention.

Because neither Schell nor Tompkin disclose or suggest any layer which may serve as a protective foil (*e.g.*, having a sufficient thickness) being structured so that an underlying tactile perceptible intaglio print is covered such that “the tactile perceptibility of the intaglio printing is maintained” (*e.g.*, by providing corresponding gaps or window areas in the protective foil), Applicants submit that the rejection is improper and, therefore, respectfully request the withdrawal of the rejection of claims 1, 14 and 16.

Claims 2-6, 8-10, and 12-13 depend from claim 1 and are patentable for at least the same reasons as claim 1 as well as for the additional features they recite. Claim 15 depends from claim 14 and is patentable for at least the same reasons as claim 14 as well as for the additional features recited. Applicants, therefore, respectfully request the withdrawal of the rejection of claims 2-6, 8-10, 12-13, and 15.

Claim 7 was rejected under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin and further in view of U.S. Patent No. 6,474,695 to Schneider et al. (“Schneider”). Schneider relates to a security thread with characters and patterns that are readable to the naked eye and/or machine. Schneider fails to cure the deficiencies of Schell and Tompkins because it too fails to disclose or suggest a “protective foil” as required by the independent claims. Claim 7

depends from claim 1 and is patentable for at least the same reasons as claim 1 as well as for the additional features recited. Applicants, therefore, respectfully request the withdrawal of the rejection of claim 7.

Claim 2 was rejected under 35 U.S.C. § 103(a) as obvious over Schell in view of Tompkin and further in view of U.S. Patent No. 4,715,623 to Roule (“Roule”). Roule relates to method of impressing a secret pattern on a substrate by the use of an unlinked intaglio printing plate. Roule fails to cure the deficiencies of Schell and Tompkins because it too fails to disclose or suggest a “protective foil” as required by the independent claims. Claim 2 depends from claim 1 and is patentable for at least the same reasons as claim 1 as well as for the additional features recited. Applicants, therefore, respectfully request the withdrawal of the rejection of claim 2.

**Conclusion**

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner withdraw all presently outstanding objections and rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

Respectfully submitted,



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